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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,985	02/05/2004	Scott R. Presnell	97-15C5	1077

7590 12/20/2004

Michelle L. Johnson
Patent Department
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EXAMINER

ANDRES, JANET L

ART UNIT PAPER NUMBER

1646

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,985

Applicant(s)

PRESNELL ET AL.

Examiner

Janet L. Andres

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: sequence comparison.

DETAILED ACTION

1. Claim 1 is pending and under examination in this office action.

Priority

2. Applicant's priority claim to provisional applications 60/071676 and 60/044886 is acknowledged. However, the claimed sequences do not appear in these applications and the priority date for this invention is thus that of 09/066745, 24 April 1998.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent application 2003/0082677.

2003/0082677 discloses SEQ ID NO: 4 (murine EDIRF 1), which is identical to instant SEQ ID NO: 12. See paragraph 0082, figure 2, and the sequence listing. The signal sequence is described in paragraph 75; thus the application also teaches the sequence of instant SEQ ID NO:

39. The sequence and signal sequence are disclosed in figure 2 of a parent application, 08/994890, filed December, 1997. The sequence alignment is attached.

NO CLAIM IS ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Andres whose telephone number is 571-272-0867. The examiner can normally be reached on Monday, Tuesday, Thursday, Friday, 8:00-4:30.

Art Unit: 1646

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Andres, Ph.D.
16 December 2004


JANET ANDRES
PRIMARY EXAMINER

Publication No. US20030082677A1

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; GENERAL INFORMATION:
; APPLICANT: Holtzman, Douglas A.
; APPLICANT: McCarthy, Sean A.
; APPLICANT: Pan, Yang
; APPLICANT: Gearing, David P.
; TITLE OF INVENTION: NOVEL EDIRF, MTR-1, LSP-1, TAP-1, AND PA-I MOLECULES
; TITLE OF INVENTION: AND USES THEREFOR
; FILE REFERENCE: MNI-107CP2
; CURRENT APPLICATION NUMBER: US/09/774,381
; CURRENT FILING DATE: 2001-01-30
; PRIOR APPLICATION NUMBER: 08/941,354
; PRIOR FILING DATE: 1999-09-30
; PRIOR APPLICATION NUMBER: 09/010,674
; PRIOR FILING DATE: 1998-01-22
; PRIOR APPLICATION NUMBER: 60/061,149
; PRIOR FILING DATE: 1997-10-06
; PRIOR APPLICATION NUMBER: 09/014,347
; PRIOR FILING DATE: 1998-01-27
; PRIOR APPLICATION NUMBER: 60/061,159
; PRIOR FILING DATE: 1997-10-06
; PRIOR APPLICATION NUMBER: 09/474,151
; PRIOR FILING DATE: 2000-12-21
; PRIOR APPLICATION NUMBER: 09/004,206
; PRIOR FILING DATE: 1998-01-08
; PRIOR APPLICATION NUMBER: 60/061,143
; PRIOR FILING DATE: 1997-10-06
; PRIOR APPLICATION NUMBER: 09/483,414
; PRIOR FILING DATE: 2000-01-14
; PRIOR APPLICATION NUMBER: 09/213,571
; PRIOR FILING DATE: 1998-12-18
; PRIOR APPLICATION NUMBER: 08/994,890
; PRIOR FILING DATE: 1997-12-19
; NUMBER OF SEQ ID NOS: 59
; SOFTWARE: PatentIn Ver. 2.0
; SEQ ID NO 4
; LENGTH: 180
; TYPE: PRT
; ORGANISM: Mus musculus
US-09-774-381-4

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Query Match 100.0%; Score 976; DB 10; Length 180;
Best Local Similarity 100.0%; Pred. No. 5e-86;
Matches 180; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

[illegible]